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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,005	10/25/2000	Albert Evaraerts	56117 USA 1A	4526

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EXAMINER

FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

14

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/697,005

Applicant(s)

EVARAERTS ET AL.

Examiner

Justin R Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoechst (JP 63-154781, of record). Hoechst is applied in the same manner as set forth in Paper Number 9, Paragraph 2.

Hoechst discloses an adhesive element composed of (i) a base or substrate, (ii) a lower layer composed of a binder resin (e.g. acrylate, synthetic rubbers, block copolymers) and a tackifier in an amount greater than or equal to 30 weight percent (equivalent to latent, over-tackified adhesive) and (iii) an upper layer composed of a solid plasticizer compatible with said tackifier, wherein the thus formed assembly (base or substrate layer, lower layer, and upper layer) is heated and applied/adhered to a second substrate layer (Page 3 of applicant's translation). Regarding the step of "applying" the plasticizing agent to activate the adhesive, Hoechst teaches that the plasticizing agent is melted by heating, at which time it mixes with or is "applied" to the latent, over-tackified adhesive in order to activate the adhesive; it being emphasized that dependent claim 6 requires "heat is applied to the plasticizing agent to cause it to activate the adhesive".

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Regarding claim 2, note that the upper layer of Hoechst is applied after the lower layer is applied to the base or substrate.

With respect to claim 4, Hoechst suggests that the upper layer (plasticizer-containing layer) can include a binder (adhesive), such that the plasticizer and adhesive are simultaneously applied to the substrate (Abstract).

It is noted that claims 17 and 18 are product-by-process claims and even though these claims are defined by the process, determination of patentability is based on the product itself (i.e. the patentability of the product does not depend on its method of production). In this instance, claims 17 and 18 fail to require structure not disclosed by Hoechst. There is no difference between the claimed adhesive article and the adhesive article made by the process of Hoechst which includes the use of heat to activate/form a pressure sensitive adhesive.

#### ***Allowable Subject Matter***

3. Claim 2 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims **and the following suggested amendment**. It is suggested that applicant amend the claim to require that the plasticizing agent is applied at room temperature to activate the latent, over-tackified adhesive, as set forth in the original disclosure (Page 20, Lines 1-8). By incorporating such language, it is clearly set forth that the activation of the adhesive is caused by the application of the plasticizing agent absent any additional heating, which is significantly different from the processing described by Hoechst in which the assembly (base, adhesive, plasticizing agent) is heated to obtain the desired adhesive characteristics.

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The prior art of record fails to disclose, teach, or suggest modifying Hoechst such that Hoechst's step of applying the plasticizing agent containing layer (instead of the heating step) activates the binder so as to form a pressure sensitive adhesive. The following is a suggested form of the amended claim:

A method of applying a pressure sensitive adhesive to a substrate; the method comprising:

providing a substrate;

applying a latent, over-tackified adhesive to the substrate; and

applying a plasticizing agent to activate the latent, over-tackified adhesive at room temperature to form a pressure sensitive adhesive, wherein said applying of the plasticizing agent occurs subsequent to said applying of the latent, over-tackified adhesive.

### ***Response to Arguments***

4. Applicant's arguments filed March 18, 2003 have been fully considered but they are not persuasive. Applicant contends that an essential element of Hoechst is the introduction of heat to melt the plasticizing agent and thus activate the adhesive. Applicant further states that the inventive concept differs from Hoechst in that once the plasticizing agent is added, the pressure sensitive adhesive is activated (becomes tacky) without the need to apply heat.

As noted in the rejection of claims 1-18 above, the claims as currently drafted require that the adhesive is activated by the application of the plasticizing agent.

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Hoechst discloses that the plasticizing agent is mixed with or “applied” to the adhesive layer (lower layer) in order to activate the adhesive. While the mixing or application of the plasticizing agent in Hoechst occurs due to heating, the claims fail to require activation at room temperature, as appears to be the case from the examples described in the original disclosure. Thus, Hoechst is directed to a method of forming a pressure sensitive adhesive in which a plasticizing agent is applied to an adhesive layer in order to activate the adhesive, the application step being the mixing of the plasticizing agent with the adhesive layer due to the application of heat.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(703) 605-4397**. The examiner can normally be reached on M-F (7:30-4:00).

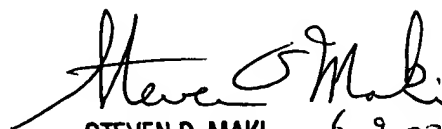
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Justin Fischer

June 9, 2003

  
STEVEN D. MAKI  
PRIMARY EXAMINER  
~~GROUP 1300~~  
AU 1733 6-9-03